

**REMARKS**

In the Office Action of March 16, 2006, the Office Action objects to portions of the specification, objects to some of the claims, rejects all claims under 35 U.S.C. § 101, and rejects all claims over one or more references, either under 35 U.S.C. § 102 or § 103. The Applicants traverse these rejections, and requests that the rejections be withdrawn.

Regarding objections to the Specification, Applicants have submitted replacement paragraphs with edits included. Paragraphs 0079, 0080, 0081 and 0091 have been amended as suggested by the Office Action. Applicants submit that the amendments to these paragraph clarify the meaning of the statements in a manner which does not add new matter, and which would be understood by one having skill in the art.

Regarding objections to the Claims, Applicants have submitted edited claims which are believed to bring the claims in compliance with all requirements of 35 U.S.C. § 112. Applicants submit that these edits have been made to clarify the claims and to make explicit that which would be implicit to one having skill in the art. Moreover, many of these claims have merely been amended to move the word "and" to a different space in the claim. Applicants are not aware of any requirement that the word "and" be moved as such, but have no objection to such a move. Moreover, Applicants do not agree with the characterization that claim 30 was not enabled as written, but have chosen to amend the claim for purposes of clarity all the same.

Regarding the rejection of the claims under 35 U.S.C. § 101, Applicant submits that this rejection should be withdrawn as moot. Applicant submits that this rejection

has been rendered moot by the decision in *Ex parte Lundgren*, (BPAI October 2005), recently rendered by the Board of Patent Appeals and Interferences, in which a technical effects test is held inapplicable under 35 U.S.C. § 101. Applicant thus submits that the rejection under section 101 has been rendered moot and should be withdrawn.

To the extent that the Office considers this rejection distinguishable from that which was shown to be incorrect in *Ex parte Lundgren*, Applicants submit that the claims involved all relate to manipulation of data in computers, and thus produce a tangible result. In particular, manipulation of such data results in changes in electrical charges in memory or magnetic properties of magnetic media when the data is stored. Moreover, the Office Action points out that no process step of displaying a file or printing a file is included. However, the Office Action thereby betrays an underlying understanding of one skilled in the art – namely that such a file would exist as a result of the claimed methods, and that any reasonably skilled user of a computer (much less than one skilled in the art) would be able to use such a file for purposes of display on a monitor or printing on a printer. The presence of the file, whether it is further manipulated for viewing by a user, is a tangible result. That a tool must be used to sense this result (such as a disk drive or a circuit in a computer) makes the file no less tangible. The same can be said for a data structure as well.

Regarding the rejections under 35 U.S.C. §§ 102 and 103, Applicants submit that the Office Action fails to provide a detailed action pointing out which portions of the prior art teach specific claim limitations. Some level of specificity is required under MPEP § 707, to allow Applicants to evaluate the Office's position and understanding of claim terms. Here, the Office Action repeatedly cites the entire document of a

reference for the proposition that the reference teaches one or more limitations, and provides no guidance as to how the Office interprets any given limitation (e.g. citation of columns 1-14 and figures 1-5 of Moody, which has 14 columns and 5 figures). Accordingly, Applicants submit that the rejections of the Office Action of March 16, 2006 should be withdrawn, and an Office Action based on detailed citations to the references should be supplied.

Moreover, each of the references teaches away from limitations of the claims, thus suggesting that the combinations of references are not appropriate. For example, in Serbinis '466, Fig. 2, element 61 suggests that the documents of the document system are stored in each of their different versions at a server – thereby teaching away from the concept of transmission of difference files – a difference file would be counterproductive in a system where different full versions of applications are stored. Similarly, Fig. 5A of Moody '177 suggests that documents are compared by going word by word through a document, thereby teaching away from use of a binary tree of segments of a document against which changes can be compared. Additionally, it is not obvious to Applicants that Aiken '626 uses a binary tree for segments – the segments appear to be sorted in a list.

Thus, Applicants submit that the rejections of the claims under 35 U.S.C. §§ 102 and 103 are improper and should be withdrawn. Alternatively, Applicants submit that such rejections should be spelled out with detailed citations to the cited references, so that Applicants can understand the Office position and then have an opportunity to respond to a non-final office action on the merits of this application.


**CONCLUSION**

If the Examiner believes that a conference would be of value in expediting the prosecution of this application, the Examiner is cordially invited to telephone the undersigned counsel at (650) 838-4300 to arrange for such a conference.

No fees are believed to be due beyond those for which a check is enclosed, however, the Commissioner is authorized to charge any underpayment in fees to Deposit Account No. 50-2207, including any funds necessitated due to an accompanying check being drawn on an account with insufficient funds.

Respectfully submitted,

Date: September 18, 2006

  
Glenn Von Tersch  
Reg. No. 41,364

Correspondence Address:

Customer No. 22918  
Perkins Coie LLP  
P.O. Box 2168  
Menlo Park, CA 94026-2168  
(650) 838-4300